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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,701	06/01/2001	Steven W. Lundberg	296.022US1	2505
21186	7590	10/25/2005	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402			AMSBURY, WAYNE P	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 10/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/872,701	LUNDBERG, STEVEN W.	
	Examiner	Art Unit	
	Wayne Amsbury	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-61 and 63-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-61 and 63-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/1/05</u> . | 6) <input type="checkbox"/> Other: _____ |

CLAIMS 1-13, 15-61 and 63-96 ARE PENDING

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Applicant's arguments with respect to claims **1-13, 15-61 and 63-96** have been considered but are moot in view of the new ground(s) of rejection.

3. **Claims 1-13, 15-61 and 63-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al (Simpson), US 6,549,894, 15 April 2003 and Schneider, US 5,987,464, 16 November 1999.**

Simpson is directed to a computerized docketing system that includes tracking and docketing patent applications [COL 1 line 66 and after]. Simpson does not explicitly address access to the system over the Internet, although as shown in FIG 1-9, the preferred embodiment is a Windows system as commonly applied in a PC used as a workstation.

Schneider is directed to updating data records having an expiry time [COL 1 lines 9-12], which includes patent information [COL 2 lines 15-20]. Schneider does not address the details of managing docketing tasks during prosecution. However, Schneider discussed the general utility of having subscribers to an updating service use an on-line system [COL 1 lines 15-40; COL 4 lines 54-61; COL 11 lines 58-65].

Official Notice is taken that law firms that prosecute patent applications are distributed over sites that may be remote from each other.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide access to the system of Simpson through the Internet as set forth by Schneider because docketing information is time sensitive information, and the combination allows docketing information to be tracked and appropriate alerts issued remotely.

As to **claim 1**:

A system for managing patent application data via the Internet, comprising:

a matter module, the matter module operable to manage data relating to patent matters, the managed data comprising docketing data, the docketing data generated within the system, the docketing data generation based on patent laws and rules governing patent prosecution;

Simpson teaches the use of matters modules [COL 5 lines 7-27].

a tasks module, the tasks module operable to manage tasks related to each matter managed by the matter module, the tasks comprising docketing tasks and other tasks generated automatically within the system and based on patent laws and rules governing patent prosecution;

Typical tasks associated with matters are set forth in Simpson at COL 1 line 66 to COL 2 line 36.

a security module, the security module operable to restrict Internet access to patent application task and matter data management to selected system users; and

As set forth by Simpson at COL 5 lines 28-48, users are limited by security concerns in various ways.

Simpson does not specify that this function is a module per se, but clearly it is a specific function that can be organized and managed as a module for purposes of efficiency in coding and maintenance. The users in the combined system have access over the Internet.

a messaging module operable to provide messaging to users of the system wherein messages are sendable from within matters in the matter module and accessible within matters.

Simpson provides messages concerning due dates in a color format to users [COL 5 lines 51-67]. Schneider displays messages over the Internet and also applies email to communicate with users [COL 12 lines 15-33].

As to **claims 2-13**, creating, retrieving and editing of tasks and particular matters are necessary functions of the system of both Simpson and Schneider. Attorneys of particular organizations and/or inventors or other users specify particular applications and/or patent interests [Simpson COL 7 lines 1-12 and elsewhere]. Simpson displays a calendar [claim 11]. Login is the initial act of a user of a PC or workstation connected through the Internet [claim 12].

As to **claim 16**, Simpson teaches that multiple users are sent reports generated by one/or more of them [COL 3 lines 4-17, lines 40-52].

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As to **claim 20**, neither Simpson or Schneider notes the use of Java, but the use of on-line access in Schneider strongly suggests that Java may be applied to develop code.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Java because it is an object-oriented language that is more portable and easier to use than many other languages, it is more robust and manages memory on its own.

As to **claims 22-23**, Schneider is directed to subscribers connected to the system over the Internet, who may archive data, which is typically done into another database [COL 6 lines 8-14]. The data itself may be acquired over the Internet and thus from another database [COL 5 lines 10-17 and elsewhere].

The elements of claims **15, 17-19, 21, 24-61 and 63-96** are rejected in the analysis above and these claims are rejected on that basis.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Amsbury whose telephone number is 571-272-4015. The examiner can normally be reached on M-F 6-18:30 FIRST WEEK.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WPA


WAYNE AMSBURY
PRIMARY PATENT EXAMINER